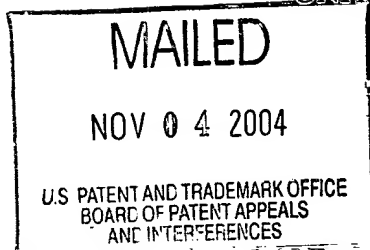


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PI-WEI CHIN, DANIEL GRAHAM DOUGLAS,
EDWARD JOSEPH GALLAGHER and BENJAMIN FRANKLIN YEE

Appeal No. 2004-1077
Application No. 09/161,073

ON BRIEF

Before THOMAS, KRASS and NAPPI, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 3-16 and 18-22.

The invention is directed to user interfaces. More particularly, the interface provides different-language versions of mark-up language resources so that, for example, pages of documents on the World Wide Web are adapted to varying languages and/or target audiences.

Representative independent claim 3 is reproduced as follows:

3. A user interface, comprising:

a markup-language encoded template having a replacement variable within; and

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a plurality of resource files containing data for replacing said replacement variable, said replacement variable being selectively replaced by data from a selected one of said resource files, each of the plurality of said resource files containing an idiomatically-correct predefined passage of text in a different language such that said replacement variable will be unambiguously replaced with a respective said passage of text governed by the selection of a particular one of said resource files.

The examiner relies on the following references:

Fukumochi et al. (Fukumochi)	5,644,774	Jul. 1, 1997
Levy	5,944,790	Aug. 31, 1999 (filed Jul 19, 1996)
Motoyama	6,208,956	Mar. 27, 2001 (effective filing date may 28, 1996)

Berg, Cliff, "How do I Write an International Application," Dr. Dobb's Journal (July 1997)
(Berg)

Claims 3-16 and 18-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 3-16 and 18-22 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Motoyama with regard to claims 3, 5, 6, 21 and 22, adding Fukumochi with regard to claims 11, 16 and 18-20, and further adding Levy with regard to claims 14 and 15. With regard to claims 4, 7 and 8, the examiner offers Motoyama and Levy. The examiner offers Motoyama and Berg with regard to claims 9 and 10, adding Fukumochi with regard to claims 12 and 13.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that because the amendment after final, filed December 27, 2002 (Paper No. 22), was refused entry by the examiner,¹ the independent claims 3, 11 and 21 before us on appeal are those presented in Appendix X (page 24) of the brief, and include the language that the replacement variable will be “unambiguously” replaced. The dependent claims 4-10, 12-16, 18-20 and 22, before us on appeal are those presented in Appendix IX (pages 20-23) of the brief.

We consider, first, the rejection of claims 3-16 and 18-22 under 35 U.S.C. § 112, second paragraph, since we must first establish whether the claims are definite enough to make it clear to artisans what the metes and bounds of the invention are, and, if applicable, to be able to determine whether the claimed subject matter is amenable to an application of prior art.

It is the examiner’s position that the use of the term “unambiguously” is vague and indefinite and it is unclear how this term is to be interpreted within the context of the instant claim limitations.

The inquiry under 35 U.S.C. § 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed—not in a vacuum,

¹This decision by the examiner was affirmed (Paper No. 27) on petition.

but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Appellants counter that “unambiguously” was used to emphasize that data from a dictionary, having many differing, ambiguous definitions, is not the type of data used by the claimed invention. Appellants also contend that a finding that “unambiguously” is ambiguous is “nonsensical” (brief-page 9). Employing a dictionary definition, appellants contend that something “unambiguous” is “something liable to only one interpretation and also something that is certain and definite” (brief-page 9).

We have reviewed the record and we conclude therefrom that the examiner has presented a reasonable case for showing the indefiniteness of the claims which appellants have not convincingly overcome.

In particular, we find, as did the examiner, that the language “unambiguously” is indefinite as it does not provide the reasonable degree of precision and particularity which is required under 35 U.S.C. § 112, second paragraph. We cannot ascertain what meaning is intended by reciting that a replacement variable will be “unambiguously replaced . . .” If it is only that a replacement variable *will* be replaced with a passage of text, then the insertion of the adverb, “unambiguously,” to modify “replaced” would appear to be otiose.

Yet, each word in a claim should be given consideration as to its particular meaning in the claim. But, it is not clear what meaning we are to ascribe to “unambiguously.” Appellants

say that the term was used to emphasize that data from a dictionary, having many differing, ambiguous definitions is not the type of data used by the claimed invention. Appellants appear to be arguing a negative limitation, contending that the term is used to imply something which is *not* part of the instant claimed invention, rather than what, specifically, the invention *is*. If this is appellants' argument, then, clearly, the claims do not particularly point out and distinctly claim the subject matter which appellants regard as their invention, as required by the second paragraph of 35 U.S.C. § 112.

Appellants' statement that something "unambiguous" is "something liable to only one interpretation and also something that is certain and definite" is certainly true, standing by itself. But, in applying the language to the instant claims, we find "unambiguously" to be anything but unambiguous. What does it mean to say that something is "unambiguously" replaced with something else? Is it replaced or is it not replaced? If it is not replaced, then there is no replacement at all, not merely an "unambiguous" replacement. If it is replaced, then, again, there is nothing ambiguous or unambiguous about it. It is merely replaced. The term is subject to too many interpretations as to ascertain any precise meaning to the language. Is it that the replacement act, itself, is "unambiguous" or is it that the thing that is doing the replacing, i.e., the substituted text passage, is "unambiguous"? It is not clear.

Appellants attempted to amend the claims to substitute the word "always" for "unambiguously." While this amendment is not before us, and therefore, we make no determination as to the definiteness of "always," if this is an indication of appellants' intended

meaning, we cannot agree that “unambiguously” means the same thing as “always.” While the former refers to something that is liable to only one interpretation, something certain and definite (as defined by appellants at page 9, lines 21-23 of the brief), the latter refers to something that happens at all times. So, again, the use of the term, “unambiguously” in reciting that a replacement variable will be “unambiguously” replaced with a passage of text, does not particularly point out and distinctly claim the subject matter considered by appellants to be their invention.

As mentioned supra, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. However, the prior art offers no guidance in analyzing the term, “unambiguously” in the context of the instant claims. A traditional, non-technical meaning given to the term, “unambiguously,” results in the confusion discussed supra. Yet, when we look to the instant disclosure, we find nothing therein that discusses or defines a replacement variable being “unambiguously” replaced with a passage of text.

Because the claimed term, “unambiguously,” offers so many interpretations as to its meaning, within the context of the instant claims, and the instant disclosure offers no particular definition, we find that the artisan would not be able to ascertain the metes and bounds of the patent property defined by the instant claims in the event the instant application should mature into a patent with these claims.

Accordingly, we will sustain the rejection of claims 3-16 and 18-22 under 35 U.S.C. § 112, second paragraph.

Turning to a consideration of the prior art rejections under 35 U.S.C. § 103, we note that, because of the problem in ascertaining the meaning of “unambiguously,” we are in a quandary as to what the invention defined by the claims actually involves. Accordingly, we cannot resolve the issues of obviousness with any degree of certainty and will, therefore, reverse the 35 U.S.C. § 103 rejection of these claims since one may not properly apply prior art under 35 U.S.C. § 103 if claim interpretation is confusing under 35 U.S.C. § 112, second paragraph. Cf. In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962).

By making this technical reversal of all prior art based rejections, we do not mean to imply that the art relied upon by the examiner would not be relevant relative to claims of the present scope containing definite limitations.

CONCLUSION

We have sustained the rejection of claims 3-16 and 18-22 under 35 U.S.C. § 112, second paragraph. We have not sustained the rejection of claims 3-16 and 18-22 under 35 U.S.C. § 103, although this reversal is only a technical one.

Accordingly, the examiner’s decision is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

BOARD OF PATENT
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ROBERT E. NAPPI
Administrative Patent Judge

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